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10/822,196	04/09/2004	Takehiro Kaminagayoshi	418268014US	2318
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EXAMINER D'AGOSTINO, PAUL ANTHONY				
ART UNIT 3714		PAPER NUMBER		
NOTIFICATION DATE 07/28/2010		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentprocurement@perkinscoie.com

# Office Action Summary

**Application No.**

10/822,196

**Applicant(s)**

KAMINAGAYOSHI, TAKEHIRO

**Examiner**

Paul A. D'Agostino

**Art Unit**

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 April 2009.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-40 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☒ Claim(s) 1-5 is/are allowed.  
6) ☒ Claim(s) 6-40 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 09 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO/SI/08)  
Paper No(s)/Mail Date 6/29/2010  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This responds to Applicant's Arguments/Remarks filed 04/08/2009. Claims 1, 6, 10, 14, 20, 24, 32, and 36 have been amended. Claims 1-40 are now pending in this Application.

#### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/8/2009 has been entered.

#### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 14-19, 20-23, and 32-40 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter wherein the medium encompasses non-transitory storage media. Examiner recommends changing A computer-readable medium" to – A computer-readable non-transitory medium --. Other wordings will be considered however the use of non-transitory shall overcome the rejection. Appropriate attention is required.

4. Claims 32-40 are rejected under 35 U.S.C. 101 because the subject matter claimed is a series of screen displays amounting to software per se in the absence of any set of instructions which may be stored on the computer-readable medium recited in the preamble.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 32-40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention without undue experimentation. Applicant has not disclosed an embodiment wherein a memory device includes a screen display. The claim is not broad, it is just incomprehensible.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 32-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant has not disclosed critical aspects of the

system hardware and software which actually makes possible the claimed screen displays.

***Claim Interpretation under 35 USC § 112, sixth paragraph***

9. Claims 24-31 recite means for and are in a form invoking 112, 6<sup>th</sup> paragraph. Applicant meets the disclosure requirement wherein the means are software routines represented as flowcharts and displays (Figs. 4-6 and Figs. 11-12) which execute on the CPU of the game console (Figs. 1-2).

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 6-10, 20-22, and 24-27, 29, and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Pub. No. 2004/0143852 to Meyers (Meyers).

**In Reference to Claims 6, 10, 20, and 24-25**

Meyers discloses multiplayer and non-multiplayer games ([0017]) under the control of NPC software ([0049]) and PCs ([0003]), the non-multiplayer games are one

or more games which are suitable for play by a single player ([0003, 0017]; see also establishing a non-MMORPG game "which can be open for others to join" [0017]), the method comprising;

receiving a request from a first player to initiate the game ([0017]),

receiving a first control input from the first player controlling a first character in response to the first control input received from the first player (using the player's PC [0003] input controls the player moves his player-controlled character through the game world [0012]);

controlling a second character in response to computer-readable instructions (Meyers discloses NPCs which can be controlled by the software instructions [0047]);

receiving a request from a second player to control the second character (Meyers discloses company sponsoring which allows skilled and experienced gamers to take over the NPCs [0047]);

in response to the request from the second player (Meyers discloses that the player-controlled NPCs enter the game unbeknownst to the single player. This entry implicitly requires logging in by the second player who has received gaming information at another remote gaming PC. The second player then selects an NPC to control which Examiner reasonably interprets to be "receiving a request to gate crash" after receiving "information about the game to a second gaming system"), transitioning control of the second character from the computer-readable instructions to the second player, wherein the first player is unaware of a transition of the second character's control from the computer-readable instructions to the second player, and wherein the first player is

substantially unaware of which character's control may be transitioned to the second player (Meyers discloses that skilled players take over the NPC and when not under the control of the players, the NPCs revert back to their robotic responses [0047]; Examiner reasonably interprets "hybrid solution" [0047-0050] such that through the skill, experience, and script requirements to run an NPC properly, a player would not know that control has transitioned from the computer to a second player.);

receiving a second control input from the second player and  
controlling the second character in response to the second control input received from the second player (inputs through "scripts" or guidelines of actions the NPC should take [0048]).

In Reference to Claims 7, 21, 26, and 29

Meyers discloses that the players are using local {remote} computers. The players in [0047-0048] would be as well to a host computer ([0003]) over the Internet ([0003]).

In Reference to Claims 8, 27 and 31

Meyers transitions the players in the absence of notifying the player is implicit in [0047-0050] wherein a) Meyers doesn't state that the player is notified and moreover, b) wherein Meyers discloses that the NPCs are to be operated in a consistent and continuous basis ([0047-0050]) which one can reasonably assume means that players

can expect some form of unpredictability from typical robotic NPCs but not such that it becomes immediately obvious by atypical NPC behavior or lack of responsiveness that the NPC has transitioned control.

In Reference to Claim 9

Meyers discloses more than one NPC such that a plurality of controls are executed by scripts to control the NPCs ([0047-0050]). For example, Meyers discloses that player-controlled NPCs can be "live" continuously or be required to be "online" a certain number of hours in a day. So, while some player-controlled NPCs may be offline (meaning they are back running under the control of NPC software ([0049]) other NPCs can be active. If the second player maintains one NPC offline, his third set of input commands are then directed to the NPC he decides is online.

In Reference to Claim 22

See rejection of Claims 4 and 7.

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148



USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
14. Claims 11-12 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meyers in view of Quake III (Quake) manual (Id Software, 1999) of record.

Meyers discloses a system substantially equivalent to Applicant's claimed invention wherein Meyers provides information regarding the different types of NPC characters (e.g., "sage" [0049]) and of a NPC database of facts ([0051-0052]). However, Meyers is silent wherein the player receives this information, how it is sorted, and of character selection.

Quake discloses computer controlled opponents ("Gladiators" pages 3-8) wherein in a single player mode (page 19) or a multiplayer mode (page 28) a player can choose an area each having a filtered [sorted] list by those opponents in the chosen arena ("Choose Level" page 19).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the interface of Quake wherein both player and computer controlled characters are displayed into the teachings of Meyers in order to provide the user of a player controlled NPC to select the computer controlled character he desires to control from a displayed list of available characters in order to make the game world

less static by controlling the NPC characters bringing a degree of unpredictability to the game (Meyers [0010]).

15. Claims 13, 23, and 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Meyers in view of Hoefelmeyer et al. (Hoefelmeyer).

Meyers discloses a system substantially equivalent to Applicant's claimed invention. However, Meyers is silent wherein a peer-to-peer connection is established with a remote system.

Hoefelmeyer discloses a peer-to-peer connection with a remote network (Fig. 1) wherein users select a game to join and establish game preferences (Fig. 8) for one of more games (Fig. 6 and [0054-0055]) in order to allow gamers to enjoy remote gaming but to also establish a peer gaming session less vulnerable to bandwidth limitations and network attacks [0003].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the peer-to-peer connection as taught by Hoefelmeyer into the teachings of Meyer in order to provide additional means of remote game play less susceptible to bandwidth limitations and network attacks.

16. Claims 32-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meyers.

Meyers discloses the claimed invention except for the specific arrangement and/or content of indicia (printed matter) set forth in the claims. It would have been obvious to one of ordinary skill in the art at the time the invention was made to create screen displays, since it would only depend on the intended use of the assembly and

the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. In re Gulack, 217 USPQ 401 (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of computer interface does not alter the functional relationship of the game system or method. Mere support by the substrate (screen) for the printed matter (display content) is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter e.g. displays comprising specified data entry fields and the substrate e.g. the display screen which is required for patentability.

***Allowable Subject Matter***

17. Claims 1-5 are allowed.
18. The following is a statement of reasons for the indication of allowable subject matter: the prior art of record neither anticipates nor renders obvious the claimed invention wherein, in combination with the other claim limitations, the method comprises receiving a request from a first player to enable gate crashing in the game by a second player wherein the game is configured to be a single player game. U.S. Patent No. 2003/0125112 to Silvester teaches of allowing crashers in a multiplayer mode but fails to disclose receiving a request by the single player to allow crashing. The request to crash the game happens at a later point in time and is initiated by the crasher himself.

U.S. Patent No. 2004/0143852 to Meyers is also a multiplayer game, but it is also disclosed that there are non-MMORPG games which can be played by a single player, wherein crashers can take over NPCs unbeknownst to the player. Yet, like Silvester, there is no request received from the first player to enable crashing. Crashing happens automatically. There is no way for the player to elect to have crashing occur or not occur. Note, those claims that have been rejected based on Meyers are those that have not positively claimed the transmission of a request by the first player (Claim 6) of where it is not specified that the first player is sending the election request (Claim 10).

### ***Response to Arguments***

19. Applicant's arguments with respect to Claims 1-40 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

20. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure is provided in the Notice of References Cited.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A. D'Agostino whose telephone number is (571) 270-1992. The examiner can normally be reached on Monday - Friday, 7:30 a.m. - 5:00 p.m..

22. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dmitry Suhol can be reached on (571) 272-4430. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

23. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Paul A. D'Agostino/  
Examiner, Art Unit 3714